

## **REMARKS**

The Office Action mailed March 21, 2006 has been carefully reviewed and the following remarks are made in consequence thereof.

Applicant's respectfully request the attorney docket number, as shown on the front page of the Office Action as 13D13211, be corrected to conform with the filing receipt such that the correct attorney docket number is 13DV13211.

Claims 1-20 are pending in this application. Claims 1-20 stand rejected. Claims 1, 5, 8, and 13 are objected to.

The objection to Claims 1, 5, 8, 13, and 17 due to informalities is respectfully traversed.

Claim 1 has been amended to recite "at least one of said tables further comprising at least one failure mode associated with the error proofing example, the error proofing example including at least one failure mode and meta-data defined by the user when creating the at least one error proofing example wherein said database accessed by each said client via said server" in accordance with the suggestion in the Office Action. Accordingly, the cited informalities have been removed from Claim 1.

Claim 5 recites "said class that provides access to said database formats SQL statements." This recitation is described in the specification at page 3, line 26, for example. As such, Applicants respectfully request the objections to Claim 5 be withdrawn.

Claim 8 recites "part families." This recitation is described in the specification at page 5, line 4, for example. Accordingly, Applicants respectfully submit that the recitation of "part families" is associated with an error proofing example. As such, Applicants respectfully request the objections to Claim 8 be withdrawn.

Claim 13 recites "error proofing technique." This recitation is described in the specification at page 1, line 4, for example. Accordingly, Applicants respectfully submit that the recitation of an "error proofing technique" is described as an error proofing methodology. Applicants respectfully submit an error proofing methodology cannot fairly be equated with an error proofing document. As such, Applicants respectfully request the objections to Claim 13 be withdrawn.

Claim 17 recites “said class that provides access to said database formats SQL statements.” This recitation is described in the specification at page 3, line 26, for example. As such, Applicants respectfully request the objections to Claim 17 be withdrawn.

For the reasons set forth above, Applicants request that the objection to Claims 1, 5, 8, 13 and 17 be withdrawn.

The rejection of Claims 1-12 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is respectfully traversed. However, Applicants have amended Claim 1 to address the rejection set forth in the Office Action. Applicants respectfully submit that Claim 1 is not directed only to software per se, because the claim includes physical structure of the machine in terms of its hardware. Claim 1 has been amended to recite a “computer system comprising a plurality of clients . . . a server . . . said database comprising a plurality of tables . . .” More specifically, a computer system provides physical structure of the machine and is clearly hardware. Additionally, a server and clients are each hardware as shown in Figure 1 and described in the specification. Accordingly, Claim 1 is submitted to satisfy the requirements of Section 101.

Dependent Claims 2-12 depend from independent Claim 1. When the recitations of Claims 2-12 are considered in combination with the recitations of Claim 1, dependent claims 2-12 are submitted to satisfy the requirements of Section 101.

For at least the reasons set forth above, Applicants respectfully request that the Section 101 rejection of Claims 1-12 be withdrawn.

The rejection of Claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Serbinis et al. (U.S. Pat. No. 6,584,466) “Serbinis” in view of Pretz (U.S. Pat. No. 6,014,658) is respectfully traversed.

Serbinis describes a system for managing electronic documents over the Internet that uses an Internet-accessible server programmed to provide document management services, such as, document storage and retrieval, collaborative file sharing and workflow services for electronic documents, an electronic document delivery service, and a document distribution service. These services are supported by a common database system that permits interfaces to the multiple services to be accessed using previously known web browsers, and without a specialized client application. Notably, Serbinis does not describe nor suggest a database that

includes error proofing examples or a method of identifying an error proofing technique, for choosing an error proofing technique to fit a given application, or storing an error proofing technique within a database. Additionally, Serbinis does not describe nor suggest a database that includes one failure mode associated with the error proofing examples when creating the error proofing examples.

Pretz describes a computer-based system for facilitating exchange of information between a third party computer owner and a technical service representative. The computer owner calls the representative for help with their computer. The owner explains to the representative the error messages he received. The technical service representative is to identify the owner's problem by entering the error messages into software that includes a database. If the database has a pre-existing solution to the problem, the software will provide the representative with the pre-existing solution. If the database does not have a pre-existing solution to the problem, the representative will develop a solution using research methods. Once a solution is developed, the representative will enter the solution into the database and will communicate the solution to the owner and exit the software. The solution is then stored in the database to help the next third party with a similar question. Notably, Pretz does not relate to error proofing as is known in the art, as a method of eliminating errors in a process, but rather describes a simple question and answer solution that does not provide feedback to a process to eliminate errors, but only serves as a help desk for users with questions.

Preliminarily, as is known in the art, error-proofing is a manufacturing technique of preventing errors by designing the manufacturing process, equipment, and tools so that an operation literally cannot be performed incorrectly. Applicants respectfully submit that those skilled in the art of designing error proofing techniques and methods to ensure their accuracy and currency would not consider Pretz to be of consequence to accomplish the objectives of the present invention in light of the unique operating requirements of managing error proofing technique development as compared to the database described in Pretz. Thus, for at least this reason, Applicant submits that the § 103 rejection is improper and respectfully requests that it be withdrawn.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (MPEP 2143.03). Applicants respectfully submit that neither Serbinis nor Pretz, considered alone or in combination, describe or suggest the claimed invention. Claim

1 recites a computer system including “a plurality of clients, each said client comprising a plurality of user interface classes and at least one class that provides access to a database. . . a server comprising a plurality of servlets, at least some of said servlets providing at least one of a database and server access capability to each said client. . . and said database comprising a plurality of tables, at least one of said tables comprising at least one error proofing example entered by a user and meta-data entered by the user that describes the at least one error proofing example, at least one of said tables further comprising at least one failure mode associated with the error proofing example, the error proofing example including at least one failure mode and meta-data defined by the user when creating the at least one error proofing example wherein said database accessed by each said client via said server.”

Neither Serbinis nor Pretz, considered alone or in combination, describes or suggests a system as recited in Claim 1. Specifically, neither Serbinis nor Pretz, considered alone or in combination, describes or suggests a database that includes a plurality of tables wherein at least one of the tables includes at least one error proofing example entered by a user. Moreover, neither Serbinis nor Pretz, considered alone or in combination, describes or suggests a database that includes at least one table that includes at least one failure mode associated with the error proofing example. Further, neither Serbinis nor Pretz, considered alone or in combination, describes or suggests that the error proofing example, at least one failure mode, and meta-data are defined by the user when creating the error proofing example. Rather, as stated in the Office Action, Serbinis does not explicitly disclose an error proofing example, and Pretz merely describes a user calling a technical service representative for help with a computer problem wherein the technical service representative tries to identify a solution to the owner’s problem by entering the problem into a computer, and software on the computer provides the representative with a pre-existing solution to the owner’s problem, and as such, does not describe nor suggest an error proofing example.

Accordingly, Serbinis and Pretz simply do not describe nor suggest any of an error proofing example entered by a user, meta-data entered by the user to describe the error proofing example, failure modes associated with the error proofing example, or that the error proofing example, failure modes and/or meta-data are defined by the user when creating the error proofing example. Therefore, since all of the claim limitations are not taught or suggested by the prior art, the Office action fails to establish *prima facie* obviousness of the claimed invention.

Moreover, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to a person having ordinary skill in the art at the time the invention was made to include an error proofing example in the system of Serbinis. More specifically, it is respectfully submitted that a *prima facie* case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Although it is asserted within the Office Action that Serbinis teaches the present invention except for disclosing an error proofing example, and that Pretz discloses that a user that talks to a technical service representative to obtain answers, no motivation nor suggestion to combine the cited art has been shown, and, in particular, no reasonable expectation of success has been shown, because neither Serbinis nor Pretz describe or suggest a database that includes a plurality of tables wherein at least one of the tables includes at least one error proofing example entered by a user. Since there is no teaching nor suggestion in the cited art

for the claimed combination, the Section 103 rejection is based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 1-20 be withdrawn.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Serbinis in view of Pretz.

Claims 2-12 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-12 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-12 likewise are patentable over Serbinis in view of Pretz.

Claim 13 recites a method for identifying an error proofing technique for a given application using a web-based computer system wherein the system includes a plurality of clients including a plurality of user interface classes, a server including a plurality of servlets, and a database including a plurality of tables including at least one example of an error proofing technique entered by a user and user defined meta-data that describes the error proofing example wherein the method includes “using at least one interface class to provide access to a database. . . using at least some of the servlets to provide at least one of database and server access capability to a client. . . entering at least one example of an error proofing technique by a user and meta data entered by the user to describe the error-proofing example. . . accessing a table containing an error proofing example. . . storing failure modes in the table associated with the error proofing example. . . and choosing an error proofing technique to fit the given application.”

No combination of Serbinis and Pretz describes nor suggests a method as recited in Claim 13. Specifically, no combination of Serbinis and Pretz describes or suggests a method that includes the step of entering at least one example of an error proofing technique by a user. Moreover, no combination of Serbinis and Pretz describes or suggests a method that includes the step of choosing an error proofing technique to fit the given application. Rather, as stated in the Office Action, Serbinis does not explicitly disclose an error proofing example, and Pretz describes a user calling a technical service representative for help with a computer problem wherein the technical service representative tries to identify a solution to the owner’s problem by entering the problem into a computer, and software on the computer provides the

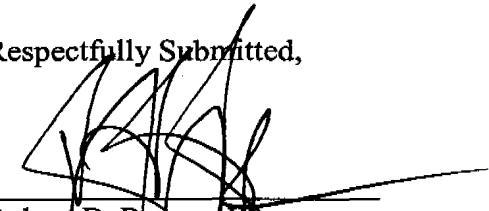
representative with a pre-existing solution to the owner's problem, and does not describe an error proofing example and does not even describe a database at all. Accordingly, for at least the reasons set forth above, Claim 13 is submitted to be patentable over Serbinis in view of Pretz.

Claims 14-20 depend, directly or indirectly, from independent Claim 13. When the recitations of Claims 14-20 are considered in combination with the recitations of Claim 13, Applicants submit that dependent Claims 14-20 likewise are patentable over Serbinis in view of Pretz.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1-20 be withdrawn.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

  
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